

**Remarks:**

The amendments above and these remarks are responsive to the final Office action dated December 1, 2006, and are being filed under 37 C.F.R. § 1.114 in support of the accompanying Request for Continued Examination. Claims 1-7, 9, 10, and 15-20 are pending in the application. In the final Office action, the Examiner (1) rejected claims 1 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite; and (2) rejected each of the pending claims under 35 U.S.C. § 103(a) as being unpatentable over a combination of references. Applicant traverses the rejections, contending that each of the pending claims is definite and is patentable over the cited references.

Nevertheless, to expedite the issuance of a patent, and to more particularly point out and distinctly claim aspects of the invention that applicant would like to patent now, applicant has amended claims 1 and 15. Applicant reserves the right to pursue the amended claims, in original or previously presented form, at a later time. Furthermore, applicant has presented remarks showing that claims 1-7, 9, 10, and 15-20 are not indefinite and are patentable over the cited references. Accordingly, in view of the foregoing amendments and the following remarks, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.114 and allowance of the pending claims.

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**I. Request for Continued Examination**

Applicant is submitting herewith a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This Request complies with the requirements of 37 C.F.R. § 1.114. In particular:

- (i) Prosecution in the application is closed, since the last Office action was a final Office action under 37 C.F.R. § 1.113.
- (ii) The Request is accompanied by a submission as set forth at 37 C.F.R. § 1.114(c), specifically, the amendments and remarks set forth herein.
- (iii) The Request is accompanied by the fee set forth at 37 C.F.R. § 1.17(e).

Accordingly, applicant respectfully requests grant of this Request for Continued Examination.

**II. Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 1 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner asserted that the phrase "selecting a coupon from the coupon set and a characteristic of the coupon based on the expected value of the coupon" is indefinite. Applicant traverses the Section 112 rejections, contending that each of the pending claims is definite as written. Nevertheless, to expedite the issuance of a patent, and to more particularly point out and distinctly claim aspects of the invention that applicant would like to patent now, applicant has amended claims 1 and 15 to clarify that both a coupon and a characteristic are selected based on the expected value and in distinct processes.

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Applicant believes that each rejection under 35 U.S.C. § 112 has been addressed fully by these claim amendments and thus the rejections should be removed.

**III. Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected each of the pending claims under 35 U.S.C. § 103(a) over a combination of references. Claims 1-4, 7, and 15-20 were rejected as being unpatentable over Linden (U.S. Patent No. 6,912,505) in view of Herz (U.S. Patent No. 6,571,279). In addition, claims 5, 6, 9, and 10 were rejected as being unpatentable over Linden in view of Herz and further in view of DeLapa (U.S. Patent No. 6,076,068). Applicant traverses the rejections, contending that independent claims 1 and 15, and all of their dependent claims, are patentable over the cited references for at least the reasons set forth below.

**A. Claims 1-7, 9, and 10**

Claim 1, as amended, is directed to a method of providing coupons:

1. (Currently Amended) A method of providing coupons, the method comprising the steps of:

identifying items in a current transaction;

assigning an expected value to each coupon of a coupon set based on a comparison of the identified items with a predictor set that links expected value to each coupon of the coupon set;

selecting a coupon from the coupon set and a characteristic of the coupon based on the expected value of the coupon; [[, the]]

selecting a characteristic of the selected coupon based on the expected value of the selected coupon and in a process distinct from selecting a coupon, the characteristic corresponding to one or more of size, print quality, spacing, position, orientation, and color of the selected coupon; and

printing the selected coupon with the selected characteristic.

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In the Office action, the Examiner rejected claim 1 as being obvious over a combination of Linden and Herz. Applicant traverses the rejection because the cited references, taken alone or in combination, do not teach or suggest every element of claim 1. For example, the cited references do not teach or suggest "selecting a characteristic of the selected coupon based on the expected value of the selected coupon and in a process distinct from selecting a coupon, the characteristic corresponding to one or more of size, print quality, position, orientation, and color of the selected coupon" and "printing the selected coupon with the selected characteristic."

Linden relates predominantly to the use of product viewing histories, such as a history of web browsing, to identify related products. However, Linden also discloses recommendations offered to customers within physical stores (col. 30, line 56, to col. 31, line 12). For example, Linden discloses providing a discount coupon to a user at check-out time based on the items purchased by the user. Nevertheless, Linden does not teach or suggest selecting a coupon based on the expected value of the coupon or selecting a characteristic of the selected coupon based on the expected value of the selected coupon, as recited by claim 1.

Herz relates to a location enhanced information delivery system. For example, Herz discloses an in-store version of the system that relies on "shopper loyalty" cards. The cards are used to identify each shopper at the check-out counter, to allow generation of a detailed shopper profile over the course of several store visits. More particularly, Herz states that "in time, the vendor develops a highly detailed database that connects shoppers to purchase items, prices and coupons" (col. 23, lines 8 and 9).

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The system of Herz also involves presenting the shopper with coupons and promotions at an in-store electronic kiosk (but not the check-out counter), based on the shopper's profile.

In the Office action, the Examiner asserted that Herz discloses changes in coupon appearance as the expected value of the coupon changes:

As the expected value changes, the coupon appearance changes (Herz, Column 24, Lines 34-36). When the appearance of the coupon changes, the pixels that are printed on the paper are rearranged and thus, the characteristic positioning and orientation of the pixels are changed. [see Office action, December 1, 2006, page 3, last five lines]

In other words, the Examiner apparently suggested that the selection of coupon identity necessarily results in selection of an appearance (and thus a characteristic) of the coupon. However, claim 1 recites selecting a characteristic of the coupon based on the expected value of the coupon and in a process distinct from selecting a coupon. Herz does not disclose selection of any of the recited coupon characteristics in a distinct selection process.

In summary, neither Linden nor Herz, taken alone or in combination, teaches or suggests every element of amended independent claim 1. Accordingly, claim 1 should be allowed. In addition, claims 2-7, 9, and 10, which depend from claim 1, also should be allowed for at least the same reasons as claim 1.

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**B. Claims 15-20**

Claim 15, as amended, is directed to a system for printing coupons:

15. (Currently Amended) A system for printing coupons, comprising:

an input device configured to identify items in a current transaction;

a processor that includes a correlation data structure in which each coupon of a coupon set is linked to a predictor set and an expected value, where the processor is operatively connected to the input device and configured to create a transaction file from the identified items, to assign the expected value to each coupon of the coupon set based on a comparison of the transaction file with the predictor set of each coupon, [[and]] to select a coupon of the coupon set ~~and a characteristic of the coupon~~ based on the expected value of the coupon, and to select a characteristic of the selected coupon based on the expected value of the selected coupon and in a process distinct from selection of the coupon, the characteristic corresponding to one or more of size, print quality, ~~spacing~~, position, orientation, and color of the selected coupon; and

a printer operatively connected to the processor and configured to print the selected coupon with the selected characteristic ~~selected by the processor~~.

In the Office action, the Examiner rejected claim 15 as being obvious over a combination of Linden and Herz. Applicant traverses the rejection because neither of the cited references, taken alone or in combination, teaches or suggests every element of independent claim 15. For example, based on the reasoning presented above in relation to claim 1, neither reference teaches or suggests a processor configured "to select a characteristic of the selected coupon based on the expected value of the selected coupon and in a process distinct from selection of the coupon." Accordingly, claim 15 should be allowed. In addition, claims 16-20, which depend from claim 15, also should be allowed for at least the same reasons as claim 15.

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**IV. Conclusion**

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to Examiner M. Bekerman, Group Art Unit 3622, Commissioner for Patents, at facsimile number (571) 273-8300 on January 31, 2007.



Christie A. Doolittle

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